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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,064	04/13/2001	Giovanni Giuffrida	HRL065	3890

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EXAMINER
ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
2165	

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
09/835,064</td><td>Applicant(s)
GIUFFRIDA ET AL.</td></tr>
<tr><td>Examiner
Neveen Abel-Jalil</td><td>Art Unit
2165</td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   The Request for Reconsideration filed on July16, 2004 has been received and entered.

Claims 1-16 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-5, 7-13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by

Syeda-Mahmood (U.S. Patent No. 5,920,856).

        As to claims 1, and 9, Syeda-Mahmood discloses an apparatus, a method for

automatically extracting metadata from electronic documents comprising a first processing

element, a second processing element, a reasoning element, and a database (See figure 1),

wherein,

        i)   said first processing element is further configured to convert electronic documents

into files (See column 7, lines 1-39, also see column 12, lines 47-55);

        ii)   said first processing element is configured to provide the files to a second

processing element (See column 7, lines 1-39, wherein "first processing element" reads on "

translator module" residing with the meta database since it converts electronic documents from

different Web sites into records stored at a central location);

iii)   said second processing element is configured to receive said files and extract

predetermined information (See column 7, lines 1-45);

iv)   said second processing element is further configured to provide said extracted

predetermined information to said reasoning element (See column 7, lines 1-45, wherein "second

processing element" reads on "search agent", wherein ""predetermined information" reads on

"metadata");

v)   said database is configured to also provide input to said reasoning element (See

column 7, lines 15-38);

vi)   said reasoning element is configured to use a set of rules to extract metadata from

the files (See column 6, lines 1-22, and see column 7, lines 14-38);

vii)   reasoning element provides an output of metadata (See column 5, lines 24-38,

wherein "reasoning element" reads on "refining module").

As to claims 2, and 10, Syeda-Mahmood discloses an apparatus for automatically

extracting metadata from electronic documents, wherein said files are substantially format

invariant data files such as Postscript files (See column 5, lines 47-65).

As to claims 3, and 11, Syeda-Mahmood discloses wherein said predetermined

information is substantially spatial layout facts (See column 9, lines 51-67, and see column 10,

lines 15-36).

As to claims 4, and 12, <u>Syeda-Mahmood</u> discloses wherein the second processing

element and said database simultaneously input to the reasoning element (See column 4, lines 6-

17).

As to claims 5, and 13, <u>Syeda-Mahmood</u> discloses wherein said set of rules can be

updated (See column 6, lines 1-22, and see column 7, lines 14-38).

As to claims 7, and 15, <u>Syeda-Mahmood</u> discloses wherein said metadata is provided to a

user interface (See <u>Syeda-Mahmood</u> column 4, lines 6-51, also see column 9, lines 11-38,

wherein "user interface" reads on "browser").

As to claims 8, and 16, <u>Syeda-Mahmood</u> discloses wherein said metadata is provided to a

storage medium (See <u>Syeda-Mahmood</u> column 6, lines 1-59, and see <u>Syeda-Mahmood</u> column 7,

lines 29-59).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 16, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Syeda-Mahmood</u> (U.S. Patent No. 5,920,856) in view of <u>Chang et al.</u> (U.S. Patent No. 6,584,479 B2).

        As to claims 6, and 14, <u>Syeda-Mahmood</u> does not teach wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents.

        <u>Chang et al.</u> teaches wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents (See column 5, lines 35-67, and see column 6, lines 1-9).

        Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified <u>Syeda-Mahmood</u> to include wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents.

        It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified <u>Syeda-Mahmood</u> by the teaching of <u>Change et al.</u> to include wherein said metadata is substantially comprised of title, author, affiliation, author affiliation, and table of contents because it allows for user customization of query refinement selections and faster access to query results.

Response to Arguments

6.   Applicant's arguments filed on September 28, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that "it is unclear how the examiner interpreted the elements of Figure 1 to read on the first processing element, the second processing element and the reasoning element, further the applicant note that the translator module is not shown in Figure 1" is acknowledged but is not deemed to be persuasive.

The Examiner refers to figure 1 to show the preamble of the claim. Broadly interpreted a processing element is any device capable of running software to read/access/edit/and output information such as being indicated by Syeda-Mahmood in column 7, lines 1-39 when refereeing to the presence of a translator module inside the database thereby making the database capable of performing one that processes, especially an apparatus for preparing, treating, or converting material (See www.dictionary.com). A main processor either within or coupled to the database as disclosed by Syeda-Mahmood in column 7, lines 1-45 is considered to be the second processor. A computer in this case can have its main processor plus a secondary processing device "translator module" coupled together. Broadly interpreted a reasoning element is any device capable of analysis or algorithm or data interpretation, which is clearly disclosed by the cited reference. A search agent (See Syeda-Mahmood figure 1) is capable of being a reasoning element.

The Examiner would respectfully like to point out that the applicant is responsible for the whole reference and not merely the portions indicated by the examiner.

In response to applicant's "disagreement with the Examiner's characterization of the translator module. The applicant submits that the translator of Syeda-Mahmood is not the same

thing as converting electronic documents from different websites into records stored at a central

location" is acknowledged but it is not deemed to be persuasive.

The Examiner submits that the translator of Syeda-Mahmood is broadly interpreted to

read on the element of the claim because when receiving files over the Internet, Syeda-Mahmood

can further store or extract information from a database which is well known in the art to store all

information as records. Records in themselves can be files or any other form of data.

The Examiner would also like to state that Syeda-Mahmood abstract, and figure 1

discloses a database, which in itself as well known in the database art stores all input as records.

All information documents searched will be translated and can be stored in a database (in records

format) as disclosed by Syeda-Mahmood column 7, lines 1-39.

In response to applicant's argument that "the applicant does not see anywhere in any of

the figures of the Syeda-Mahmood patent there is any indication that the translator module

provides any files to the search agent" is respectfully acknowledged but it is not deemed to be

persuasive.

The Examiner points to Syeda-Mahmood abstract, and column 7, lines 3-45, wherein

database that holds the translator module (responsive to the distributed queries) is capable of

being updated by a refining module that is coupled to the system. The search agent extract

information from databases across the web, and the translator module resides in one or more of

these databases accordingly information is being extracted by the search agent that has been

processed though the translator.

In response to applicant's argument that "the search agent of the Syeda-Mahmood patent does not receive files and extract predetermined information as disclosed in claim 1" is acknowledged but is not deemed to be persuasive.

The Examiner points to column 9, lines 12-38 wherein Syeda-Mahmood disclosed extraction schemes are created, used, and stored. Anytime a database is present it holds/stores any information the user defines therefore, Syeda-Mahmood by having access to the meta-database for information extraction and refining is also disclosing re-storing this information back in the database see abstract.

In response to applicant's argument that "Syeda-Mahmood does not teach, disclose, or suggest "said second processing element is further configured to provide said extracted predetermined information to said reasoning element" is acknowledged but is not deemed to be persuasive.

The Examiner maintains that indeed query patterns are predetermined information stored within a database. A database has predefined/predetermined structure and pattern matching rules for information storage and retrieval. In Syeda-Mahmood column 6, lines 10-29, an initial meta-database is constructed from structured query template is disclosed. Templates are predetermined set of information. Syeda-Mahmood discloses that the search agent extracts metadata from the database. See Syeda-Mahmood column 8, lines 31-55, wherein information is extracted information is being organized, clustered, and categorized is also disclosed.

In response to applicant's argument that "Syeda-Mahmood does not teach said reasoning

element is configured to use a set of rules to extract metadata from the files" is acknowledged

but is not deemed to be persuasive.

The Examiner maintains that Syeda-Mahmood teaches in column 7, lines 15-55 that a

database of metadata is being searched and information is being extracted accordingly the data is

being processed first as input then as translation and latter as output. Syeda-Mahmood teaches in

column 8, lines 26-56 extracting information then re-processing that information, thereby

indicating that more than one processing element is present and capable of performing the steps

of the invention. Broadly interpreted by the examiner, Syeda-Mahmood's invention contain two

processing elements, one is the general processor of the computer, the second is contained in the

database whereby translation, analysis, and document processing takes place.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074.

The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici can be reached on 571-272-4038. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Neveen Abel-Jalil
January 9, 2005

SAM RIMELL
PRIMARY EXAMINER